

REMARKS/ARGUMENTS

Upon entry of the present paper, claims 12, 16 and 17 will have been amended and are being submitted for reconsideration by the Examiner. In view of the above, Applicants respectfully request reconsideration of the outstanding rejections of the all claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Office Action provided. Claims 12-18 are pending and stand rejected.

In the outstanding Office Action, claims 12 and 15-17 were rejected under 35 U.S.C. § 103(a) over HUNA (U.S. Patent No. 6,944,273). Claims 13 and 18 were rejected under 35 U.S.C. § 103(a) over HUNA in view of RANALLI et al. (U.S. Patent No. 6,748,057). Claim 14 was rejected under 35 U.S.C. § 103(a) over HUNA in view of GOODMAN (U.S. Patent No. 6,735,617).

However, Applicants respectfully traverse the above rejections and submit that these rejections are each inappropriate and improper. In particular, none of the cited and applied references, whether considered alone or in any proper combination contain a disclosure adequate to render the pending claims unpatentable.

As noted above, Applicants have amended claims 12 and 16-17 for consideration by the Examiner. Applicants respectfully traverse the above rejections based on pending claims 12-18 and will discuss said rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Claims 12-15 and 18 generally relate to a server apparatus connected to a transmitting IP apparatus. The transmitting IP apparatus transmits an e-mail to a receiving IP apparatus via the server apparatus. The server apparatus includes a memory configured to store an IP address of the receiving IP apparatus in association with a telephone number of the receiving IP apparatus. The IP address of the receiving IP apparatus is distinct from an e-mail address. The server apparatus further includes a receiver configured to receive the e-mail from the transmitting IP apparatus. The e-mail includes the telephone number of the receiving IP apparatus.

The server apparatus further includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus. The receiving IP apparatus of the IP address is the same as the receiving IP apparatus of the telephone number. The server apparatus further includes a transmitter configured to transmit the received e-mail to the receiving IP apparatus of the telephone number, based on the stored IP address of the receiving IP apparatus. Claim 16 recites a generally related system. Claim 17 recites a generally related method.

HUNA relates to an apparatus and method for entering and transmitting a message, at a future delivery time, to a receiving device that is coupled either to a telephony-centric network or to a data-centric network. In HUNA, for receiving devices 532 connected to a data-centric network, the message server 402 (514) translates the message into a format compatible with the receiving device 532 and initiates delivery of the message. For receiving devices 520, 524, 528 connected to a telephony-centric network, the message server 402 (514) embeds a telephone number of the receiving device 520, 524, 528 into the message. The IP address of “the local POP

408 (516) (not an IP address of the receiving device 520, 524, 528)” corresponding to the embedded telephone number of the receiving device 520, 524, 528 is obtained, and the message is routed to the IP address of the local POP 408 (516) (col. 15, lines 52-60 and col. 16, lines 53-58).

HUNA does not disclose that the message server 402 (514) obtains, from a received e-mail, the telephone number of a receiving IP apparatus, and obtains, from a memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number. Each of these features is explicitly recited in e.g. claim 12.

Furthermore the Office Action incorrectly asserts (at page 4, lines 5-6) that HUNA teaches that the receiving IP apparatus of the IP address is the same as the receiving IP apparatus of the telephone number (col. 15, lines 50-60). What HUNA does disclose, at the above cited portion, is that for receiving devices 532 connected to the data-centric network 406, the message server 402 (514) routes messages directly to the IP address of the receiving device (col. 15, lines 52-54). Thus, the message server 402 (514) does not embed a telephone number of a receiving device 532 into the message, since no telephone is necessary in when utilizing the data-centric network.

On the other hand, for receiving devices 520, 524, 528 connected to the telephony-centric network, HUNA discloses that the message server 402 (514) embeds the telephone number of the receiving device into the message along with contact protocol for the receiving device, and routes the message to the IP address of “the local POP 408 (516)” corresponding to the embedded telephone number. Upon reception of the message, the local POP 408 (516) directs the local

switch 454 to call the receiving device over the telephony-centric network (col. 15, lines 54-62). Thus, the receiving device (whose phone number is embedded) is explicitly disclosed to be distinct from the local POP 408 (516), which is the IP apparatus of the IP address.

In neither scenario does HUNA teach that the receiving IP apparatus of the IP address (i.e., the local POP 408 (516)) is the same as the receiving IP apparatus of the telephone number (i.e., the receiving device 520, 524 or 528). Thus, the Examiner's interpretation of HUNA is incorrect.

Additionally, while HUNA discloses storage of an e-mail address, HUNA does not disclose that the server 402 (514) stores an IP address of "a receiving IP apparatus". In this regard, the claimed memory defines the IP address of the receiving IP apparatus as being distinct from an e-mail address. Col. 15, lines 19-25 does not mention storage of an IP address, and lines 51-52 disclose routing of the message to the IP address of the receiving IP apparatus, but not storage of the IP address at the message server 402 (514) or routing to an IP address based on any storage of the IP address at the message server 402 (514).

Furthermore, the Examiner's assertion that Fig. 7 shows the "To" field as indicating Richards' telephone number being distinct from Richard's IP address is not relevant to the recitations of the pending claims. Rather, according to claim 12 the IP address of the receiving IP apparatus is distinct from an e-mail address, not from a phone number as asserted by the Examiner.

The Examiner's reliance upon column 15, lines 19-25 and lines 51-55 as disclosing the memory recited in claim 12 is also misplaced. The first cited portion merely discloses that a recipient can be aliased to several receiving addresses to include a telephone number, page

number, fax number, and e-mail address. The second cited portion merely discloses that the server routes messages directed to a receiving device connected to the data-centric network directly to the IP address of the receiving device. The second cited portion continues to disclose that for those receiving devices connected to a telephony-centric network, the message router embeds the telephone number of a receiving device and contact protocol for the receiving device into the message. The receiving device is then called by the telephone and routes the message to the IP address of "the local POP 408 (516)" corresponding to the embedded telephone number. However, these portions of HUNA do not disclose a memory configured to store an IP address of the receiving IP apparatus in association with a telephone number of the receiving IP address at least because in the telephone centric network the receiving device does not even have an IP address.

Additionally, the Office Action incorrectly asserts that the claimed analyzer and transmitter are disclosed at column 15, lines 50-60. However, this portion of HUNA relates to the routing of messages either directly to a receiving device 532 or to a local POP 408 (516). For receiving devices 532 that are connected to the data-centric network 406, messages are routed directly to the IP address of the receiving device. A telephone number is not utilized in such routing for devices connected to the data-centric network 406.

On the other hand, for receiving devices 520, 524, 528 connected to the telephony-centric network, a message router embeds a telephone number of a receiving device into the message, and routes the message to the IP address of "the local POP 408 (516)" corresponding to the embedded telephone number.

Furthermore, upon the local POP 408 (516) receiving the message, the message intended for receiving devices connected to the telephony-centric network is transmitted via the telephony-centric network by the local switch 454. Thus, a transmitter in HUNA is not configured to transmit the received e-mail to the receiving IP address, based on an IP address of the receiving IP apparatus. Rather the message is transmitted by telephone.

As discussed above, when messages designated for receiving devices connected to the data-centric network 406 are routed directly to the IP address of a receiving device, the message server 402 (514) merely translates the messages into formats compatible with the receiving devices. In other words, in such a case, the message server 402 (514) does not embed any telephone number of the receiving devices into the messages, and does not rely on any telephone number of the receiving devices to obtain the IP address of the receiving IP apparatus. On the other hand, for receiving devices connected to the telephony-centric network, the message server 402 (514) embeds the telephone number of a receiving device into the message along with contact protocol for the receiving device, and routes the message to the IP address of "the local POP 408 (516)" corresponding to the embedded telephone number. However, in this case, the message server 402 (514) embeds the telephone number of the receiving device into the message 534, and sends the message 534 to the IP address of "the local POP 408 (516)" (col. 16, line 53 - col. 17, line 31). Then, the local POP 408 (516) contacts the receiving device using the embedded telephone number (col. 17, lines 43-63). Thus, the local POP 408 (516) of the IP address is different from the receiving device 520, 524, 528 of the telephone number, which contradicts the recitations of e.g. claim 12.

In either situation described in HUNA, the message server 402 (514) does not disclose the features recited in claim 12. That is, HUNA does not disclose at least a server apparatus that includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, "the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number". Further, HUNA does not disclose at least a server apparatus that includes a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Thus, since HUNA does not disclose numerous of the recitations of claims 12 and 15-17, these pending claims are allowable over HUNA.

Furthermore, the Office Action has taken Official Notice that the concept of implementing telephony over data centric network is old and the advantages of such implementation are well known in the art. While this is undoubtedly true, the purpose and function of HUNA is to enable the transmission of messages to a receiving device that is connected either to a telephony-centric network or to a data centric network. Thus, it is a specific feature of HUNA to provide the flexibility to apply to both data-centric and telephony-centric networks. In this regard, the Examiner's attention is respectfully directed to col. 13, lines 25-40. Thus, the asserted modification of replacing POTS in HUNA with a data-centric network renders an explicitly stated purpose of HUNA superfluous and unnecessary. In other words, if the entire HUNA system were converted to a data centric network, there would be no need for those aspects of the disclosure thereof dealing with the ability to transmit messages over POTS.

That is, HUNA represents an integration of IP and POTS. Thus, converting all of HUNA to a digital data centric telephone network would render the need for integration, which is a prime purpose of HUNA, totally unnecessary. For at least these reasons, the Official Notice in the Office Action is inappropriate and improper.

Yet further, the Examiner asserts in the Official Action mailed on June 21, 2007 that "Fig.5 shows addressing of a recipient via an e-mail address comprising a telephone number of the recipient. However, the claim 12 does not recite "an e-mail address comprising a telephone number of the receiving IP apparatus", but recites "the e-mail including the telephone number of the receiving IP apparatus".

In setting forth the rejection, the Examiner also asserts that "in 50:54-60 teaches that that based on this number the message is routed to the POP of corresponding telephone number. In a telephone-centric network, the only IP address a telephone number has is the address of the associated POP, and that is where the message is routed. In other words, in a telephone-centric network, all subscribers of the network, connected to a given POP, have the same IP address - that of an associated POP". However, as explained above, in HUNA, for receiving devices (Fig.5, 520, 524, 528) connected to the telephony-centric network, the message server 402 (514) embeds the telephone number of a receiving device (520, 524, 528) into the message along with contact protocol for the receiving device, and routes the message to the IP address of "the local POP 408 (516)" (but NOT to an IP address of the receiving device (520, 524, 528)) corresponding to the embedded telephone number (col.15, lines 54-60). Then, it is not the message server 402 (514) but "the local POP 408 (516)" that contacts the receiving device (520, 524, 528) using the embedded telephone number (col. 17, lines 43-63). In other words, the

message is routed from the message server 402 (514) to the local POP 408 (516) using the IP address of “the local POP 408 (516)”, and then is routed from the local POP 408 (516) to the receiving device (520, 524, 528) using the telephone number of the receiving device (520, 524, 528). Thus, the message server 402 (514) stores the IP address of “the local POP 408 (516)” corresponding to the telephone number of the receiving device (520, 524, 528), but does not store the IP address of the receiving device (520, 524, 528) corresponding to the telephone number of the receiving device (520, 524, 528).

Thus, HUNA fails to disclose the message server 402 (514) that obtains, from a memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number. Rather, HUNA discloses that the message server 402 (514) obtains, from a memory, the IP address of the receiving IP apparatus (the local POP 408 (516)) associated with the telephone number of the receiving IP apparatus (the receiving device (520, 524, 528)), the receiving IP apparatus (the local POP 408 (516)) of the IP address being NOT the same as the receiving IP apparatus (the receiving device (520, 524, 528)) of the telephone number.

Therefore, the pending claims are clearly patentable over HUNA, at least for each of the above-noted reasons.

As set forth above, the rejection of independent claim 12 is improper and should be withdrawn. The rejection of independent claims 16 and 17 is also improper and should be withdrawn at least for reasons similar to those set forth above with respect to independent claim 12 insofar as claims 16 and 17 recite a system and a method with features similar to the features

of the server apparatus recited in claim 12. Each of dependent claims 13-15 and 18 is allowable at least for depending, directly or indirectly, from an allowable independent claim, as well as for additional reasons related to their own recitations including those set forth below.

Regarding the rejection of claims 13 and 18 under U.S.C. § 103(a), HUNA does not disclose a server apparatus which includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number. HUNA also does not disclose a server that includes a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

RANALLI relates to an IP-PBX system that accepts a telephone number as a destination address, contacts a directory server, requests an IP address related to the telephone number and returns the IP address to the IP-PBX system (col. 7, lines 51-67 and col. 8, lines 1-18). However, RANALLI does not disclose at least the claimed analyzer, as defined in the pending claims. Rather, RANALLI merely teaches that an IP-PBX system contacts the directory server to request the IP address related to the telephone number and the IP address is returned to the IP-PBX system. Thus, RANALLI does not contain any disclosures regarding a server that includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus.

Further, RANALLI does not disclose at least a server that includes a transmitter configured to transmits the received e-mail to the receiving IP apparatus, based on the IP address

of the receiving IP apparatus. Rather, in RANALLI the directory server merely returns the IP address to the IP-PBX system.

Thus, the pending claims are not disclosed, suggested or rendered obvious by RANALLI and HUNA, regardless of whether RANALLI discloses error notification. Moreover, the Office Action has not set forth any proper reasoning for the proposed combination aside from the unsupported assertion that HUNA and RANALLI are analogous art. In this regard, the required reasoning cannot merely consist of the assertion that two patents come from analogous fields.

Therefore, the rejection of claims 13 and 18 is improper for at least the reasons set forth above.

Regarding the rejection of claim 14 under U.S.C. § 103(a), GOODMAN relates to a system in which, when the sender's computer 920 sends a facsimile message to the recipient's facsimile machine 975, the facsimile message is sent from the sender's computer 920 to the sender's mail server 930. An address of the facsimile machine 975 includes a telephone number of the facsimile machine 975 and a domain name of the facsimile mail server 950. The sender's mail server 930 obtains an IP address of the facsimile mail server 950 from the DNS server 945, based on the domain name of the facsimile mail server 950. The sender's mail server 930 forwards the facsimile message to the facsimile mail server 950, based on the IP address of the facsimile mail server 950. The facsimile mail server 950 selects a gateway to which the facsimile message should be forwarded and forwards the facsimile message to the selected gateway. The gateway is selected based on loads on different gateways at a time when the facsimile communication is forwarded. Ultimately, the facsimile message is delivered from

the selected gateway to the facsimile machine 975 over a conventional telephone network 970 (col. 6, lines 54-67 and col. 7, lines 1-33).

However, in GOODMAN, a telephone number is assigned to facsimile machine 975 (col. 6, lines 63-67), but an IP address is not assigned to the facsimile machine 975. The telephone number assigned to the facsimile machine 975 is a conventional telephone number (col. 6, lines 38-46). In other words, GOODMAN does not contain any disclosure regarding an IP address of the facsimile machine 975. Thus, in GOODMAN, a facsimile message is forwarded from the VOIP Outbound Gateway 956 to the facsimile machine 975 over the conventional telephone network 970, using the telephone number of the facsimile machine 975.

Further, an address, for example, 1112223333@faxservername.xxx, is utilized for forwarding a facsimile message to the facsimile machine 975. The address consists of the conventional telephone number of the facsimile machine 975 and a name of the facsimile mail server 950 (col. 6, lines 38-46 and col. 7, line 15). In other words, the address does not include an address of the VOIP Outbound Gateway 956. Thus, GOODMAN does not contain any disclosure regarding a telephone number of the VOIP Outbound Gateway 956.

Thus, GOODMAN does not disclose a H.323 gatekeeper which stores the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, since GOODMAN does not contain any disclosure regarding an IP address of the facsimile machine 975 or a telephone number of the VOIP Outbound Gateway 956. GOODMAN also does not disclose an analyzer configured to determine whether the memory stores the IP address of the receiving IP apparatus. Further, GOODMAN does not disclose a transmitter which

accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus when it is determined that the memory does not store the IP address of the receiving IP apparatus.

Additionally, Fig. 13 of GOODMAN shows a gatekeeper lookup table which contains zones, gateway addresses, and gateway priority. However, none of these teach an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus.

Further, the Office Action has not set forth any proper basis or reasoning for the combination of the teachings of GOODMAN and HUNA. The mere assertion, even if true, that GOODMAN and HUNA are in analogous arts, does not in and of itself provide the reasoning required for a proper combination under 35 U.S.C. § 103.

Therefore, the rejection of claim 14 is improper for at least the reasons set forth above.

That is, as explained above, each of the claims now pending is allowable over the documents applied in the Office Action, whether these documents are considered alone or in any proper combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

Further, pursuant to M.P.E.P. § 714.13, Applicants assert that the present amendment places the application in condition for allowance, or alternatively, in better condition for appeal. Further, the amendments to the claims do not require further search and/or consideration, and no additional claims have been added. As noted above, the claim amendments submitted herein merely clarify and amplify claim features, but do not further limit or narrow claims. Thus no new issues are raised by the amendments. Thus, Applicants submit that entry of the presently submitted amendment is appropriate and in full accordance with 37 C.F.R. § 1.116.

Accordingly, Applicants respectfully request the entry of the present amendment and allowance of the pending claims.

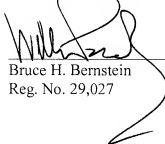
SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended the rejected claims and submitted the same for reconsideration by the Examiner. With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

The undersigned hereby authorizes the U.S. Patent and Trademark Office to charge any fees necessary to maintain the pendency of the above-identified application, including any extension of time fees to Deposit Account No. 19-0089.

Should there be any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
S. WATANABE et al.



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

August 21, 2007
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191